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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,598	02/22/2002	Otis Franklin Bell	2871	5730
26822	7590	10/29/2003	EXAMINER	
WALTER A. HACKLER 2372 S.E. BRISTOL, SUITE B NEWPORT BEACH, CA 92660-0755			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER

1762

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/082,598

Applicant(s)

BELL, OTIS FRANKLIN

Examiner

William P. Fletcher III

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-20, 23, 24, 27 and 28.Claim(s) withdrawn from consideration: 21, 22, 25 and 26.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*WPF 10/23/03*  
William Phillip Fletcher III  
Patent Examiner, USPTO  
Group Art Unit 1762

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claim 19 under 35 U.S.C. 112, 2nd Paragraph; the rejections of claims 1, 2, 11, 12, 13, and 24 under 35 U.S.C. 102(b) as being anticipated by VanWinckel (US 5,618,582 A) and the rejections of claims 6-10, 16-20, 27, and 28 under 35 U.S.C. 103(a) as being unpatentable over VanWinckel (US 5,618,582 A); these rejections having been set-forth in the Office action mailed 08/13/03.

Continuation of 5. does NOT place the application in condition for allowance because:

With respect to claims 27 and 28, the examiner did not take issue with the term "water." Rather, it is the term "solely" -- specifically as it is used to modify "water" -- that both lacks support and renders these claims indefinite. From applicant's remarks at p. 12 of the response filed 10/09/03, the limitation "solely with water" is intended to distinguish applicant's invention over that of Roberts. Applicant's coating does not need an alkaline aqueous solution to be removed, whereas Roberts requires such a stripping solution. Applicant has not set-forth any particular definition of the phrase "solely with water" as it is to be understood within the context of the invention. As stated by the examiner in the Office action mailed 08/13/03, the ordinary meaning of the term "solely" requires the exclusion of everything other than H<sub>2</sub>O.

Applicant argues that "...it is believed that the term 'solely with water' would convey to one skilled in the art, that one could practice the invention as defined in claims 27 and 28 by washing with water alone and not with a solvent, or solvent-water mixture, or water surfactant solution." The examiner disagrees as such an understanding of the phrase "solely with water" is not clearly set-forth in the specification. Further, applicant's understanding of the term "solely" appears to include some things and exclude others. In order for claims 27 and 28 to be read in light of applicant's understanding of the phrase "solely with water," a specific definition is required in the specification since it is contrary to the ordinary meaning of the term [see *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999)]. Applicant's argument is not persuasive.

Applicant also argues that Roberts does not teach applicant's claimed coating composition and that there is no motivation to combine VanWinckel and Roberts. The examiner disagrees. The elements of applicant's claims taught by both VanWinckel and Roberts are clearly set-forth in the Office action mailed 08/13/03. Consequently, this argument is not persuasive. Furthermore, both VanWinckel and Roberts disclose removable, temporary, protective coating compositions (i.e., masking compositions). Since VanWinckel suggests the use of an acrylic emulsion as a masking composition and Roberts teaches a specific acrylic emulsion masking composition, one of ordinary skill would have been motivated by the desire and expectation of utilizing the composition of Roberts to successfully provide a temporary, removable, protective coating according to the method of VanWinckel. Consequently, this argument is not persuasive.

Applicant further argues that, while Roberts teaches neutralizing the polymer, the reference does not teach solubilizing the polymer. The examiner disagrees as Roberts teaches both the polymer, neutralizing agent, and final pH as disclosed by applicant. Absent evidence to the contrary, it is the examiner's position that solubilization of the polymer would necessarily result from neutralizing the polymer according to Roberts.

With respect to applicant's arguments re: pressure washing. Pressure washing relies on a physical interaction between the mechanical force of the applied water and the coating. While Roberts teaches that the adhesive forces between the coating will not be affected by a chemical interaction with water (hence the need for a chemical reaction with an alkaline solution) the reference is silent with respect to high-pressure mechanical forces. Since pressure washing is a well-known means of removing a coating from a surface, and there is no evidence of record that the coating of Roberts would not yield to such mechanical forces, it remains the examiner's position that it would have been obvious to remove Roberts' coating via pressure washing.